

REMARKS

Claims 1, 3, 5-9, and 11-29 were pending. The applicants add new claim 30. The applicants present claims 1, 3, 5-9, and 11-30 for examination in view of the following remarks.

Interview summary

The applicants thank Examiner Grant for the courtesy of participating in a telephone interview with Sean Dean on May 3, 2010. It was agreed that the features of claim 20 distinguished the heat shrinkable film decoration method of U.S. Pub. No. 2001/0002605 ("Morawski"). It was also agreed that Morawski disclosed a heat shrinkable film applied to a toothbrush body rather than an injection-molded encapsulation covering a decoration applied to an injection-molded body.

Claim Rejections – 35 USC § 103

Claims 1, 3, 5-9, and 11-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2001/0002605 ("Morawski").

Independent claim 1

Claims 1, 3, 5-9, and 11-19 were associated re rejected under 35 U.S.C. 103(a) as obvious over U.S. Pub. No. 2001/0002605 ("Morawski"). The applicants traverse.

Claim 1 recites "a body injection-molded from a first plastic" and "an injection-molded encapsulation of a second plastic covering the decoration." In contrast, Morawski described a decorative pattern on a clear, heat shrinkable plastic film which is applied to a toothbrush body.¹ Even if claim 1 is a product by process claim, the MPEP notes that

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.²

¹ See, e.g., Morawski, paragraph [0046].

² MPEP 2113 Product-by-Process Claims [R-1] - 2100 Patentability citing *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and

A person of ordinary skill in the art could readily distinguish the structure of a part with the "injection-molded encapsulation of a second plastic covering the decoration" claimed the applicants from the structure of a part with the heat shrinkable film described by Morawski. Because the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product, the associated must be considered when assessing the patentability of claim 1 over Morawski.

Claim 1 also recites "the body comprises a transparent and/or opaque and/or translucent plastic[.]" The applicants are unable to find any indication that the toothbrush body described by Morawski comprises a transparent and/or opaque and/or translucent plastic.

Moreover, it would not have been obvious to modify Morawski to include the features recited by the applicant's claim 1. Morawski described a decorative plastic layer applied via a heat shrinking process.³ The back side of the decoration is applied to the body with the decorative side facing away from the body of the toothbrush. The applicants apply the decorative side of the decoration to a body so that the decorative side is not damaged during formation of the injection molded encapsulation. Because the body comprises transparent and/or opaque and/or translucent plastic, the decorative side of the decoration is visible through the body. A person of ordinary skill in the art would not have considered modifying the toothbrush described by Morawski because heat shrinking a plastic film doesn't require temperatures as high as injection molding of a plastic encapsulation. Thus, heat shrinking doesn't cause the problem of the features of claim 1 are designed to solve and there would be no reason modify the tooth brush described by Morawski to include these features. In addition, reversing the decoration such that the decorative side of the decoration is applied to the body would keep it from being visible. Thus, Morawski teaches away from the claimed device and therefore does not provide support for the proposed modification.⁴

noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

³ See, e.g., Morawski, paragraph [0046].

⁴ In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (If the suggested combination would produce a 'seemingly inoperative device', the references taken in combination can be said to teach away from the invention.) See also Tec Air, Inc. v. Denso Manfg Michigan, Inc., 192 F.3d 1353, 52 USPQ2d 1294 (CAFC 1999) and In re Gordon (CAFC 1984) (no suggestion to modify a prior art device where the modification would render the device inoperable...).

The dependent claims include additional features that further distinguish Morawski. For example, claims 6-8 recites features of the arrangement of the decoration and injection molded parts. The application notes that

In order that the region of the decoration is encapsulated in such a way that no contaminants can be drawn into gaps between the basic body and the encapsulation in this region, the encapsulation may extend over the basic body fully or partly beyond the edge region of the decoration.

Another possibility for the material-engaging connection is that the decoration-free regions are arranged in the region of the decoration, whereby a secure connection of the encapsulation to the basic body can be achieved even in the case of decorations covering a large surface area.

If the connection between the basic body and the encapsulation is to be made even more secure, the basic body may have in one or more of the decoration-free regions recesses which are open toward its surface and are filled by the plastic of the encapsulation, since the surface area of the encapsulated decoration-free regions is increased in this way.⁵

Thus, the claimed features have a desired structural effect and are not merely a matter of design choice. Morawski has not been shown to disclose or make obvious the claimed features.

For at least these reasons, Morawski does not make obvious independent claim 1 or any of claims 3, 5-9, 11-19, and 30 depending from claim 1.

Independent claim 20

Claims 20-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morawski. Claim 20 recites

applying at least a two-dimensional decoration to a surface of the body, the decoration having a decorative front side and a back side, the decoration applied with its decorative front side facing the body, such that the decorative front side is visible through the body; and then

covering the applied decoration with an encapsulating layer of a second plastic, the second plastic injection molded over the decoration;

In contrast, Morawski described positioning a tube of heat-shrinkable plastic film 70 having a decorated pattern about a portion of the handle of the toothbrush body.⁶ Once the tubular film

⁵ Present application (published as U.S. 2006/0123574), paragraphs [0012-0014].

⁶ See, e.g., Morawski, paragraphs [0053] and [0055].

has been positioned on the toothbrush handle, it is then heated to a temperature and for a period of time sufficient to cause the film to shrink into conforming contact with the toothbrush handle.⁷

The office action asserts that “Morawski implicitly discloses the claimed method steps while disclosing the apparatus.”⁸ This is simply incorrect. Morawski specifically describes a different method of manufacture than the applicants claim.

In particular, Morawski neither describes “applying at least a two-dimensional decoration to a surface of the body . . .; and then covering the applied decoration with an encapsulating layer of a second plastic” nor that “the second plastic [is] injection molded over the decoration.” No reason has been advanced as to why the method described by Morawski would be modified to include these features. Thus, the obviousness rejection of claims 20-29 lacks the rational underpinning necessary to support the legal conclusion of obviousness.⁹ For at least these reasons, Morawski does not make obvious independent claim 20 or any of claims 21-29 depending from claim 20.

The applicants submit that the pending claims are in condition for allowance and request notice to that effect. In the event a new office action is issued, the applicants respectfully request that the examiner identify with particularity the features of cited references that are asserted to correspond to the features of the applicants’ claims.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicants have (a) addressed certain comments of the examiner does not mean that the applicants concede other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicants concede any of the examiner's positions with respect to that claim or other claims.

⁷ See, e.g., Morawski, paragraphs [0053] and [0055].

⁸ Office action dated December 3, 2009, page 2.

⁹ See *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727 at 1740 (2007) citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” – emphasis added).

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A Request for Continued Examination and Information Disclosure Statement are being submitted with this reply. Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 02894-0711US1.

Respectfully submitted,

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